

REMARKS

Status of the Claims

Claims 1-12 are pending. Claims 9-12 are withdrawn from examination as being directed to a separate invention. Claims 1-8 are currently under examination.

Amendments to the Claim

Claims 1-9 have been amended to insert “containing a carboxy or a hydroxy group” after “*in vivo* hydrolysable ester or amide thereof.” Representative support for the phrase “containing a carboxy or hydroxy group” can be found on page 8, lines 30-33.

The amendments to claims 1-9 do not introduce prohibited new matter. Moreover, these amendments do not raise new issues requiring new search and examination since the phrase “*in vivo* hydrolysable ester or amide thereof” has already searched and examined.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-8 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The Office Action alleges that claims 1-8 provide no indication as what the phrase “*in vivo* hydrolysable ester or amide” encompasses.

Without acquiescing to the propriety of the rejection and in the interest of advancing the prosecution of this application to allowance, Applicants have inserted the phrase “containing a carboxy or a hydroxy group” after the phrase “*in vivo* hydrolysable ester or amide thereof.” The inserted phrase further describes what is encompassed by the claims.

The preparation of *in vivo* hydrolysable esters or amides is well-known in the art. Moreover, the specification on pages 8 and 9 describes in detail how to make *in vivo* hydrolysable ester or amide of a compound. As an example, on page 8, line 30 and onward, the specification provides specific examples of *in vivo* hydrolysable esters containing a carboxy or a hydroxy group. Accordingly, the specification provides adequate guidance and examples to enable the claimed invention.

The Office Action cites the Wands factors to support their position that the specification does not enable the claims. Applicants respectfully point out that the claims have been amended

to recite “*in vivo* hydrolysable ester or amide thereof containing a carboxy or a hydroxy group.” Thus, the specification enables the breadth of the claims. Moreover, as stated in the specification, it is well-known how to make *in vivo* hydrolysable esters or amides thereof, containing a carboxy or a hydroxy group. As discussed above, the specification provides sufficient guidance for and examples of *in vivo* hydrolysable esters or amides of the presently claimed compounds, containing a carboxy or a hydroxy group. Therefore, it would not require undue experimentation to make and use *in vivo* hydrolysable esters or amides of the presently claimed compounds.

Accordingly, the specification enables the claimed invention.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 1-8 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Office Action alleges that the phrase “*in vivo* hydrolysable ester or amide” renders the claims indefinite. Without acquiescing to the propriety of this rejection, Applicants have amended claim 1 to insert the phrase “containing a carboxy or a hydroxy group.” In view of the amendment, the rejection is not applicable to claims 1-8.

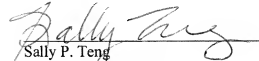
Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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